

Attorney Docket No. 812897-342
Application Serial No. 09/736,471

REMARKS

The Office Action of April 6, 2005, was received and its contents carefully reviewed. Applicants note that this is the second restriction requirement without an Office Action on the merits. Claims 1-30, and 60 are currently pending. Claims 31-59 were previously withdrawn in response to the first election/restriction requirement. In response to the April 6, 2005, Office Action, Applicants provisionally elect with traverse, Group I (claims 1-27) drawn to a method for selling a product on-line, classified in class 705, subclass 26. In order to comply with the Examiner's assertion that the application contains claims directed to patentably distinct species of the claimed invention, Applicants provisionally elect with traverse species I.a. (claims 1, 2). Applicants traverse the election restriction requirement for the following reasons outlined below.

As the Examiner indicates, claims 1-27 are directed to a method for selling a product on-line, classified in class 705, subclass 26. Claim 28 recites a computer-readable medium encoded with processing instructions for implementing a method for selling a product on-line that corresponds to at least claim 1. Of course, claim 28 is also classified in class 705, subclass 26. Additionally, claim 29 recites an apparatus for selling a product on-line written in means-plus-function form and corresponding to at least claim 1. Claim 29 is also classified in class 705, subclass 26. Claim 30 recites an additional apparatus claim that is not written in means-plus-function form, but similarly corresponds to at least claim 1. Finally, claim 60 recites a method for purchasing a product that is performed by a buyer at the other end of the transaction described by at least method claim 1.

There are two criteria for a proper requirement for restriction between patentably distinct inventions. First, the inventions must be independent or distinct as claimed (emphasis added); and second, there must be a serious burden on the examiner if restriction is required. See MPEP § 803. Applicants respectfully submit that neither is the case in the present application.

The inventions recited in claims 1-30 and 60 are not independent or distinct and instead are closely related. The inventions are related as claims 1-27 recite a method for selling a product on-line, while claims 28, 29, and 30 recite the computer-readable medium encoded with processing instructions, and the apparatus, respectively, used to carry out the method of claim 1. Claim 60 recites a method for purchasing a product that may be performed by a buyer at the other end of the transaction method recited by claim 1.

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Additionally, as all of these claims are classified in class 705, subclass 26, the field of the search is the same for all claims 1-30, and 60. Applicants respectfully assert that there is no additional burden on the Examiner, much less a serious burden. Claims 1-27 recite a method and are written to protect against a would-be infringer from practicing the method of the present invention. Claim 28 recites a computer-readable medium encoded with processing instructions and is written to protect against a would-be infringer from distributing a computer program that may facilitate and allow others to practice the method of the present invention. Claims 29 and 30 recite an apparatus and are written to protect against a would-be infringer from using a device to practice the method of the present invention. Similarly, claim 60 recites a method that a purchaser would implement to interact with the selling method recited in claim 1. There is no additional burden on the Examiner since there is no separate classification, no separate status in the art, and no different field of search is defined in MPEP § 808.02. As such, Applicants respectfully submit that restriction is improper in this case. Applicants respectfully request reconsideration and withdrawal of the previous restriction requirement made on claims 1-30, and 60.

Group I and Group II Process and Apparatus

Further, a process and an apparatus for its practice may be shown to be distinct inventions if either the process as claimed can be practiced by another materially different apparatus or by hand; or that the apparatus as claimed can be used to practice another and materially different process. See MPEP § 806.05(e). Applicants respectfully submit that neither of these requirements may be shown with regard to the present application.

The process as claimed in claim 1 is a method for selling a product on-line. Applicants respectfully disagree with the Examiner's contention that the processes recited in claims 1-27 can be practiced without the use of a computer. Specifically, claim 1 recites that the method is for selling a product on-line. As is well known in the art, on-line sales require the use of a computer or other Internet appliance (not materially different apparatuses) and may not be performed by hand. Similarly, the apparatus recited in claim 29 is recited in means-plus-function format and recites the means for practicing the method of claim 1. If the apparatus claims include a claim to "means" for practicing the process, the claim is a linking claim and must be examined with the elected invention. See MPEP § 806.05(e).

The apparatus recited in claim 30 recites structure to perform the method of claim 1. As such, the apparatus as claimed may not be used to practice a materially different process.

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See MPEP § 806.05(e). Therefore, Applicants respectfully submit that restriction requirement is improper. Applicants respectfully request reconsideration and withdrawal of the previous restriction requirement made on claims 1-30, and 60.

Group I (claims 1-27) and Claim 60 Combination and Subcombination

As described above, claims 1-27 are directed to a method of selling a product on-line, while claim 60 recites a method for purchasing a product that may be performed by a buyer at the other end of the transaction method recited by claim 1. In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. See MPEP § 806.05(c).

To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP § 808.02. As described above, there is no separate classification, no separate status, and no separate field of search. Therefore, there is insufficient support for a restriction requirement. Therefore, Applicants respectfully submit that restriction requirement is improper. Applicants respectfully request reconsideration and withdrawal of the previous restriction requirement made on claims 1-30, and 60.

Group II (claims 28, 29, and 30) Related Subcombinations

Claim 28 recites a computer-readable medium encoded with processing instructions for implementing a method for selling a product on-line that corresponds to at least claim 1. Claim 28 is classified in class 705, subclass 26. Additionally, claim 29 recites an apparatus for selling a product on-line written in means-plus-function form and corresponding to the method recited in claim 1. Claim 29 is also classified in class 705, subclass 26. Claim 30 recites an additional apparatus claim that is not written in means-plus-function form, but similarly corresponds to claim 1 and is, of course, classified in class 705, subclass 26. The Examiner indicates that invention II (claim 28) has separate utility and indicates that the search required for invention II is not required for invention III (assuming the Examiner included a typographical error when copying the previous form paragraph (i.e., Examiner indicated invention I and invention II but was discussing invention II and invention III) at the top of page 4 of the Office Action).

Similarly, the Examiner indicates that invention II (claim 28) has separate utility and indicates that the search required for invention II is not required for invention IV (assuming

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the Examiner copied and pasted the above typographical error when copying the previous form paragraph (i.e., Examiner indicated invention I and invention II but was discussing invention II and invention IV) at the middle of page 4 of the Office Action).

However, in both cases the Examiner provided no example that one of the subcombinations has utility other than in the disclosed combination as required under MPEP § 806.05(d). In fact, Applicants are at a loss to explain how the computer-readable medium encoded with processing instructions may have utility other than that of being used in an apparatus for conducting the recited method for selling a product online. Applicants respectfully request that a required example be provided in the Examiner's next correspondence. Absent such, Applicants respectfully submit that the restriction requirements are improper. Applicants respectfully request reconsideration and withdrawal of the previous restriction requirement made on claims 1-30, and 60.

Likewise, claim 29 recites an apparatus for selling a product on-line written in means-plus-function form corresponding to the method recited in claim 1. Claim 29 is classified in class 705, subclass 26. Claim 30 recites an additional apparatus claim that is not written in means-plus-function form, but similarly corresponds to claim 1 and is, of course, classified in the same class 705, subclass 26. The Examiner indicates that invention IV (claim 30) has separate utility and indicates that the search required for invention III is not required for invention IV (assuming the Examiner included a typographical error when copying the previous form paragraph (i.e., Examiner indicated invention I and invention II but was discussing invention III and invention IV) at the bottom of page 4 of the Office Action). However, the Examiner provided no example that one of the subcombinations has utility other than in the disclosed combination as required under MPEP § 806.05(d). In fact, Applicants are at a loss to explain how the apparatus with the recited structures in claim 30 may have utility other than that of being a means for carrying out the recited method for selling a product online. Applicants respectfully request that a required example be provided in the Examiner's next correspondence. Absent such, Applicants respectfully submit that the restriction requirement is improper. Applicants respectfully request reconsideration and withdrawal of the previous restriction requirement made on claims 1-30, and 60.

Group I (claims 1-27) Species

The Examiner asserts that Invention I (claims 1-27) contains 20 distinct species (I.a. through I.t.). Applicants respectfully submit that this characterization is not correct. Claims

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1-27 include a single embodiment and add additional limitations to the independent claim 1 reciting the method of the exemplary embodiment. Species, on the other hand, are always the specifically different embodiments. See MPEP 806.04(e). Clearly this is not the case with claims 1-27. As such, Applicants respectfully submit that the restriction requirement is improper. Applicants respectfully request reconsideration and withdrawal of the previous restriction requirement made on claims 1-30, and 60.

Conclusion

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper. See MPEP § 806.05.

Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), the Examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:

(1) Separate classification thereof: This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(2) A separate status in the art when they are classifiable together: Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents, which are evidence of such separate status, and also of a separate field of search.

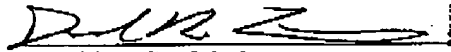
(3) A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. Since the Examiner has not provided the required explanation of the above-criteria, Applicants respectfully submit that the restriction requirement is improper. Applicants respectfully request reconsideration and withdrawal of the previous restriction requirement made on claims 1-30, and 60.

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As further suggested in the telephone restriction practice outlined in MPEP § 812.01, if the Examiner determines that a further requirement for restriction should be made in the application, Applicants respectfully request that the Examiner contact the Applicants' undersigned representative to facilitate resolution of this matter so that prosecution of the case on the merits may begin.

Respectfully submitted,



Donald R. Studebaker
Registration No. 32,815

JAP/MSK:lms

NIXON PEABODY LLP

Customer No. 22204

Suite 900, 401 9th Street, N.W.

Washington, D.C. 20004-2128

(202) 585-8000

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